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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,133	04/19/2004	Michael S. Allen	6704-29	2875

43463 7590 04/24/2006

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EXAMINER

DUNSTON, JENNIFER ANN

ART UNIT PAPER NUMBER

1636

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 10/827,133	Applicant(s) ALLEN ET AL.	
	Examiner Jennifer Dunston	Art Unit 1636	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 10 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See continuation sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-4, 6-11, 15-23, 25 and 26.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See continuation sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

### CONTINUATION SHEET

The amendment filed 4/10/2006 under 37 CFR 1.116 in reply to the final rejection has NOT been entered. The final Office action, mailed 2/10/2006, is maintained.

The proposed amendment to claim 1 requires further search and/or consideration. The scope of the proposed claim, filed 4/10/2006, is broader than the enabled subject matter indicated on pages 4-9 of the final Office action. The difference in scope between the newly amended claims and the Examiner's suggestion, which was presented in the scope of enablement rejection in the previous Office action, will require further search and/or consideration. Thus, claim 1 and claims that depend therefrom would require further search and/or consideration.

The proposed amendment to claim 2 requires further search and/or consideration and raises the issue of new matter. The claim is drawn to a nucleic acid construct comprising a nucleic acid encoding LuxA modified with a sequence that specifically binds a tail-specific protease and a nucleic acid encoding LuxB modified with a sequence at its carboxy terminus that specifically binds to a protein associated with a ubiquitin-proteasome pathway. This combination of elements was not previously presented, and thus requires further search and/or consideration. Further, this claim raises issues of new matter in that the specification does not disclose a nucleic acid encoding both LuxA and LuxB where LuxA is modified by a tail-specific protease sequence and LuxB is modified with a protein associated with a ubiquitin-proteasome pathway. The specification discloses modified LuxA and LuxB, wherein both proteins are modified by a SEQ ID NO: 8 for use in bacteria, and wherein both proteins are modified by the 178 amino acid C-terminus of the G1 cyclin Cln2 for use in yeast. The response does not point to portions of the specification, claims or drawings, as originally filed, for support for the

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amendment of claim 2. Therefore, proposed claim 2 represents a departure from the specification, claims and drawings as originally filed.

The proposed amendment to claim 4 requires further search and/or consideration in that the dependency of the claim has been changed. Thus, the scope of claim 4 has been altered by the proposed amendment. This change in scope requires further search and/or consideration.

With regard to the rejection of claim 4 under 35 U.S.C. 112, 1<sup>st</sup> paragraph, all remarks are directed to the newly amended claims. As discussed above, the amendments have not been entered and therefore the arguments are moot and will not be addressed.

With regard to the rejection of claims 1-4, 6-11, 15-23 and 25-26 under 35 U.S.C., 1<sup>st</sup> paragraph, all remarks are directed to the newly amended claims. As discussed above, the amendments have not been entered, and therefore the arguments are moot and will not be addressed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Dunston whose telephone number is 571-272-2916. The examiner can normally be reached on M-F, 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached at 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR, <http://pair-direct.uspto.gov>) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your

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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Jennifer Dunston, Ph.D.  
Examiner  
Art Unit 1636

jad

CELINE QIAN, PH.D.  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'C. Qian', written over a horizontal line.